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OFFICE OF PETITIONS

In re Patent No. 7,590,587 :
Duquette :
Issue Date: September 15, 2009 :
Application No. 10/517,960 : DECISION ON REQUEST FOR
Filed: December 14, 2004 : RECONSIDERATION OF
Attorney Docket No. 05-1124 : PATENT TERM ADJUSTMENT
Title: SYSTEM AND METHOD FOR :
ANALYZING AND DISPLAYING :
SECURITY TRADE TRANSACTIONS :

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT", filed October 7, 2009. This petition is properly treated under 37 CFR 1.705(d). Patentee requests the final PTA calculation to increase total PTA from 528 days to 1,154 days.

The application for reconsideration of patent term adjustment is **Dismissed**.

The above-identified application matured into U.S. Patent No. 7,590,587 on September 15, 2009. The patent issued with a patent term adjustment of 528 days. This request for reconsideration of patent term adjustment was timely filed within two months of the issue date of the patent. See, 37 CFR 1.705(d).

Patentee requests recalculation of the patent term adjustment based on the decision in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentee asserts entitlement to an additional adjustment of 626 days of "B delay." Thus, patentee requests that the determination of patent term adjustment be increased to a total of one thousand one hundred fifty-four (1154) days (the sum of the period of three-year delay (641 days) and the period of examination delay (683 days)

minus overlap (15 days) minus applicant's delay (155 days)). Patentee does not dispute the 155-day reduction for applicant delay.

As stated in 37 CFR 1.703(b), the period of adjustment under § 1.702(b) is the number of days in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the sum of the periods under § 1.703(b)(1)-(4). The date of completion of all 35 U.S.C. 371 requirements, December 14, 2004, is the date used in calculating examination delay under 37 CFR 1.703(a), the date the national stage commenced under 35 U.S.C. 371(f), Tuesday, December 14, 2004, is used in determining the Three Year Delay under 37 CFR 1.703(b).

National stage commenced December 14, 2004. Accordingly, at the time of issuance of the patent, the application was pending three years and 641 days, December 15, 2007 to September 15, 2009.

At issue is whether patentees should accrue 641 days of patent term adjustment for the Office taking in excess of three years to issue the patent, as well as 683 days for Office failure to take certain actions within specified time frames (or examination delay).

The Office contends that the entire 641-day period of delay in issuance of the patent overlaps with the period of 683 days of examination delay. Patentee's calculation of the period of overlap is inconsistent with the Office's interpretation of this provision. 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

to the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

Likewise, 37 CFR 1.703(f) provides that:

To the extent that periods of delay attributable to the grounds specified in §1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 56366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

As such, the period for over 3 year pendency does not overlap only to the extent that the actual dates in the period beginning three years after the date on which the application commenced overlap with the actual dates in the periods for failure of the Office to take action within specified time frames.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the entire period during which the application commenced, December 14, 2004, until the issuance of the patent on September 15, 2009. 683 days of patent term adjustment were accorded for Office delay pursuant to 37 CFR §1.702(a)(1) and (a)(2). Entry of both 641 days pursuant to 37 CFR §1.702(b) and 683 days pursuant to 37 CFR §1.702(a) is neither permitted nor warranted. The Office did not delay 683 days and then delay another 641 days. The greater period, 683 days, is the actual number of days issuance of the patent was delayed by the Office.

Accordingly, at issuance, the Office properly entered no additional days of patent term adjustment.

In view thereof, no adjustment the patent term will be made.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Charlema Grant, at (571) 272-3215.

/ALEZIA M. BROWN/

Alesia M. Brown
Petitions Attorney
Office of Petitions